

Applicant: Kadar et al.  
Application Serial No.: 10/742,308  
Filing Date: December 19, 2003  
Docket No.: P-5655/9 (102-599)  
Page 2

**REMARKS**

Reconsideration of the application is respectfully requested.

Claims 1-14 are in the application.

In the Office Action, the Examiner rejected claims 1-14 provisionally under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-8 of copending Application No. 10/742,307. Applicants at this time refrain from filing a terminal disclaimer. If the claims of the subject application are found allowable prior to the claims of copending Application No. 10/742,307, it is respectfully submitted that this application be allowed.

The Examiner rejected claims 1-14 under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 4,962,033 (Serkes et al.). In formulating the rejection, the Examiner stated,

Serkes et al. discloses a roller bottle with pleats that are perpendicular to the longitudinal axis. The reference is silent as to the pleats being offset at and [sic] angle. In *Gardner v. TEC Systems, Inc.*, ..., the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions (including angles) of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

The Examiner's assertions are respectfully traversed.

A *prima facie* showing of obviousness requires three elements:

1. some suggestion or motivation to modify a reference;

Applicant: Kadar et al.  
Application Serial No.: 10/742,308  
Filing Date: December 19, 2003  
Docket No.: P-5655/9 (102-599)  
Page 3

2. a reasonable expectation of success; and,
3. the reference must teach or suggest all of the claimed limitations.

MPEP §2143.

It is respectfully submitted that the Examiner has failed to satisfy at least the first and third requirements of a *prima facie* showing of obviousness.

**I. All of the claim limitations are not present in the prior art**

As set forth in MPEP §2143.03 “[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art.” (Emphasis applied). Claim 1 is directed to a roller bottle having a continuous side wall with a least one pleat, “said pleat being arranged at an angle offset with respect to a plane perpendicular to the longitudinal axis of said bottle”. As stated by the Examiner, Serkes et al. “is silent as to the pleats being offset at and [sic] angle.”

Admittedly, and as set forth in MPEP §2144.04, legal precedent may be relied upon to modify a reference as a basis for an obviousness rejection. Specifically, MPEP §2144.04(IV)(B) indicates that changes in shape from a prior art reference may be alone not patentable. However, as noted in MPEP §2144.04, legal precedent is not to be used where an “applicant has demonstrated the criticality of a specific limitation”. Moreover, the Examiner noted in the rejection, as quoted above, that where a claimed device and a prior art device did “not perform differently” there may not be a patentable distinction in relative dimensions between the two devices. The angularly-offset pleats as set forth in claim 1 provide a meaningful function to the

Applicant: Kadar et al.  
Application Serial No.: 10/742,308  
Filing Date: December 19, 2003  
Docket No.: P-5655/9 (102-599)  
Page 4

subject invention and allow the claimed invention to perform differently from the Serkes et al. device.

Applicants acknowledge a Serkes et al.-type roller bottle, having circumferential pleats, at paragraph [0007] of their Specification. As noted at paragraph [0014] of Applicants' Specification, an angularly-offset pleat provides "an advantage over circumferential pleats when cells are harvested from the bottle." As further noted at paragraph [0014],

In particular, cells are collected from the bottle by first pouring off the liquid growth medium and then detaching the cells from the bottle walls. Frequently, a trypsin solution is poured into the bottle and then distributed around the inside of the bottle to cover all of the cells. A continuous helical or spiral pleat path running substantially the entire length of the bottle enables the trypsin to more easily reach all of the cells because the trypsin can follow a continuous path around the pleat as the bottle is rotated about its axis. In contrast, circumferential pleats or longitudinal pleats may complicate uniform distribution of trypsin to all areas of the bottle from which cells may be harvested. Thus, a much more thorough coating with trypsin is achieved with a spiral or helical pleat.

Thus, the angularly-offset pleat provides a critical and meaningful function of allowing for better cell harvesting than with prior art devices and, clearly, performs in a different manner than the circumferential pleats of Serkes et al. It is respectfully submitted that reliance on legal precedent alone in formulating a *prima facie* obviousness rejection is not proper in the subject case. Without any prior art to combine with Serkes et al., there is no disclosure or suggestion of the claimed pleat arrangement in Serkes et al.

Applicant: Kadar et al.  
Application Serial No.: 10/742,308  
Filing Date: December 19, 2003  
Docket No.: P-5655/9 (102-599)  
Page 5

## **II. No motivation to modify Serkes et al. as suggested by the Examiner**

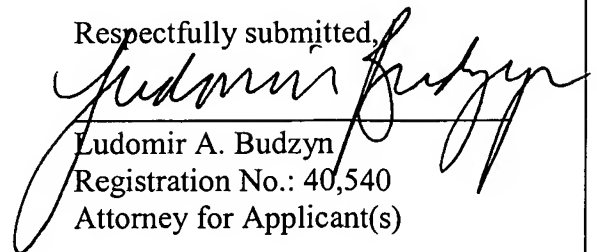
A *prima facie* case of obviousness also requires some suggestion or motivation to modify the reference. See MPEP §2143. As stated in MPEP §2143.01, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." The Examiner has not provided any basis for modifying Serkes et al. Without a basis for modifying Serkes et al. as suggested by the Examiner, there cannot be a *prima facie* showing of obviousness.

## **III. Conclusion**

In view of the foregoing, it is respectfully submitted that claim 1, along with dependent claims 2-14, are patentable over Serkes et al.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicants' attorney at the number listed below.

Respectfully submitted,



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